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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/7081	02/15/97	FLUHAK, KOSHLI	A CPO-11946-US

C2M1/0319

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 EXAMINER

DEXTER, G

 ART UNIT  
3204 PAPER NUMBER

DATE MAILED: 03/19/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/801,464</b>	Applicant(s) <b>Funakoshi et al.</b>
	Examiner <b>Clark F. Dexter</b>	Group Art Unit <b>3204</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-18 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4 and 7-13, drawn to a method of cutting with guiding, classified in class 83, subclass 523.
  - II. Claims 1, 3-5 and 7-12, drawn to method of cutting with specific detecting, classified in class 83, subclass 13.
  - III. Claims 1, 3, 4 and 6-12, drawn to method of cutting with specific cutting, classified in class 83, subclass 663.
  - IV. Claims 14-18, drawn to a cutting apparatus, classified in class 83, subclass 72.
2. It is noted that claims 1-13 are directed to a method but include substantially no active method steps. Therefore, these claims have been restricted according to the method steps recited or inferred thereby as best understood. In interpreting these claims, any limitations reciting the structure of the substrate or how the substrate is formed (specifically, claims 3, 4, 7, 8-10 and 12) have been given little weight in defining the claimed method and have thus been considered in all of the method groups.
3. Further, claims 1-10 have been restricted in a fashion similar to a genus-species restriction wherein the patentability of the invention is presumed to lie in the details of the particular group

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(e.g. the guiding of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-10 will be considered.

4. Similarly, claims 11-13 have been restricted in a fashion similar to a genus-species restriction wherein the patentability of the invention is presumed to lie in the details of the particular group (e.g. the guiding of Group I). It is noted that if claim 11 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 11-13 will be considered.

5. The inventions are distinct, each from the other because of the following reasons:

Methods (Groups I-III)

6. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of detecting (e.g., using a light source) of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the guiding of group I for patentability as evidenced by the omission thereof from group II.

7. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the specific details of cutting (e.g., using a rotary blade) of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the guiding of group I for patentability as evidenced by the omission thereof from group III.

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8. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the specific details of cutting (e.g., using a rotary blade) of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the specific details of detecting (e.g., using a light source) of group II for patentability as evidenced by the omission thereof from group III.

Method vs. Apparatus

9. Inventions I-III are related to invention IV as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus or by hand; for example, the methods can be performed manually.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax number for this group is (703)305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[rinaldi.rada@uspto.gov\]](mailto:rinaldi.rada@uspto.gov).

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter**  
**Patent Examiner**  
**Group Art Unit 3204**

cf  
March 17, 1998